



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,097	10/17/2003	Glenn C. Godoy	END920030047US1	9088

23550 7590 12/07/2006

HOFFMAN WARNICK & D'ALESSANDRO, LLC  
75 STATE STREET  
14TH FLOOR  
ALBANY, NY 12207

EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT PAPER NUMBER

2165

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,097	<b>Applicant(s)</b> GODOY ET AL.	
	<b>Examiner</b> Tomasz Ponikiewski	<b>Art Unit</b> 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Amendment filed on September 13, 2006 has been received and entered.

Claims 1-20 are pending.

2. Applicant's amendment has overcome previous claim objections and rejection under 112 2<sup>nd</sup>.

### ***Claim Objections***

3. Claim 14 is objected to because of the following informalities:

4. Claim 14 recites the word "for" in the body of the claim. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2165

6. Claims 1, 14 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 does not list any hardware (i.e. computer) tied to the steps in order to operate the steps of the claims therefore resulting in software only implementation. There is no indication in the body of the claim where the data is displayed. Similarly claims 14 and 18 have no hardware in the body.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 9, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishimura (US 2001/0051904 A1).

As per claim 1 Nishimura is directed to a method of managing custom data by computer during an electronic purchase, the method comprising:

selecting an item for purchase (page 5, paragraph 0073) ;

determining a set of attributes for the item, wherein the attributes include item-based attributes and purchase-based attributes (page 4, paragraph 0062);

Art Unit: 2165

comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the “keys” could mean the choices available for customization);

and displaying a custom data form in the case that the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

As per claim 2 Nishimura is directed to the selecting step comprises:

adding the item to an electronic shopping cart (page 7, paragraph 0101, wherein item is added to cart after the selects the item);

selecting to checkout the electronic shopping cart (page 7, paragraph 0102, lines 7-10, wherein the client determines whether the item appears to be the one selected);

and obtaining purchase information for the electronic purchase (page 7, paragraph 0103, lines 5-6).

As per claim 3 Nishimura is directed to wherein the custom data form is displayed after the obtaining step (page 7, paragraph 0103, lines 7-9).

As per claim 4 Nishimura is directed to comprising generating the custom data form for the item (page 7, paragraph 0103, lines 7-9).

As per claim 5 Nishimura is directed to comprising obtaining custom data using the custom data form (page 7, paragraph 0103, lines 7-9).

As per claim 6 Nishimura is directed to comprising storing the obtained custom data in a database (page 4, paragraph 0063, lines 8-12, wherein custom data can mean any information about the product).

As per claim 9, Nishimura is directed to the custom data form is displayed once for a plurality of items that match the set of keys (figure 9, wherein the form is displayed matching the selected data).

As per claim 14 Nishimura is directed to a system for managing custom data by a computer during an electronic purchase, the system comprising:

- a selection system for allowing a user to select an item for purchase (page 5, paragraph 0073);

- an attribute system for determining a set of attributes for the item, wherein the attributes include item-based attributes and purchase-based attributes (page 4, paragraph 0062);

- a key system for comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the "keys" could mean the choices available for customization);

- and a form system for displaying a custom data form in the case that the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

As per claim 15 Nishimura is directed to comprising a checkout system to obtain purchase information for the item (page 7, paragraph 0103, lines 5-6).

As per claim 16 Nishimura is directed to comprising a storage system to store custom data, wherein the form system further obtains the custom data using the custom data form (page 4, paragraph 0063, lines 8-12, wherein custom data can mean any information about the product).

As per claim 18 Nishimura is directed to a computer program product stored on a recordable medium for managing custom data during an electronic purchase, which when executed by a computer comprises:

program code to allow a user to select an item for purchase (page 5, paragraph 0073);

program code to determine a set of attributes for the items, wherein the attributes include item-based attributes and purchase-based attributes (page 4, paragraph 0062);

program code to compare the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the "keys" could mean the choices available for customization);

and program code to display a custom data form in the case that the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) in view of Leber et al. (US 2003/0182391 A1).

As per claim 7 Nishimura does not teach concatenating custom data obtained using at least two input fields in the custom data form.

Leber et al. does teach concatenating custom data obtained using at least two input fields in the custom data form (Leber et al., figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Leber et al. to include concatenating custom data obtained using at least two input fields in the custom data form because doing so keeps all the relevant data together.

Nishimura as modified still does not teach storing the concatenated custom data as a large object in the database.

Leber et al. does teach storing the concatenated custom data as a large object in the database (Leber et al., page 4, paragraph 0067, lines 7-8).



Art Unit: 2165

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include saving the information in a database because it is more efficient to store the data in a repository that is easily accessed.

As per claim 8 Nishimura as modified still does not teach comprising parsing the concatenated custom data to determine the custom data obtained for one of the at least two fields.

Leber et al. does teach comprising parsing the concatenated custom data to determine the custom data obtained for one of the at least two fields (Leber et al. page 4, paragraph 0067, lines 2-4, wherein "concatenated custom data" could mean "message"; figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include parsing the concatenated custom data because the data would only make sense it placed in proper format.

11. Claims 10, 12-13, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) in view of Christensen et al. (US 2002/0154114 A1).

Art Unit: 2165

As per claim 10 Nishimura is directed to a method of managing custom data by a computer during an electronic purchase, the method comprising:

- selecting an item for purchase (page 5, paragraph 0073);
- obtaining purchase information for the item (page 7, paragraph 0103, lines 5-6);
- determining a set of attributes for the item, wherein the attributes include item-based attributes and purchase-based attributes (page 4, paragraph 0062);
- comparing the set of attributes to a set of keys (page 5, paragraph 0078, lines 11-15, wherein the "keys" could mean the choices available for customization);
- displaying a custom data form in the case that the set of attributes matches the set of keys (page 7, paragraph 0103, lines 7-9);

Nishimura does not teach obtaining custom data using at least one input field in the custom data form.

Christensen et al. does teach obtaining custom data using at least one input field in the custom data form (Christensen et al., page 5, paragraph 0049, lines 21-25, wherein "input fields" could mean "selectable options").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include input fields in custom form because having more choices mean more variety to satisfy the selection.

Nishimura as modified still does not teach storing the obtained custom data and purchase information in a database.

Christensen et al. does teach and storing the obtained custom data and purchase information in a database (Christensen et al., page 5, paragraph 0049, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Christensen et al. to include saving the information in a database because it is more efficient to store the information about item and purchase data together for good recordkeeping.

As per claim 12 Nishimura as modified is directed to the storing step further comprises storing an entry in a custom data group table for a custom data group, wherein the custom data group includes each item in the electronic purchase that matches the set of keys (Nishimura, figure 2 shows table with various keys).

As per claim 13 Nishimura as modified is directed to storing the large object in an entry in a group custom data table in the case that the custom data form is displayed once for the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables);

and storing the large object in an entry in an item custom data table in the case that the custom data form is displayed for each item in the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

As per claim 17 Nishimura is directed to the storage system includes:

a custom data group table to store an entry for a custom data group, wherein the custom data group includes each item in the electronic purchase that matches the set of keys (Nishimura, figure 2 shows table with various keys);

Nishimura does not teach group custom data table to store an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group.

Christensen et al. does teach group custom data table to store an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include group custom data table to store an entry for the custom data for the custom data group if the custom data form is displayed once for the custom data group because storing data in tables is convenient and efficient process.

Nishimura as modified still does not teach an item custom data table to store an entry for the custom data for each item in the custom data group if the custom data form is displayed once for each item in the custom data group.

Christensen et al. does teach an item custom data table to store an entry for the custom data for each item in the custom data group if the custom data form is displayed

Art Unit: 2165

once for each item in the custom data group (Christensen et al., page 5, paragraph 0049, lines 48-51, wherein the database is made up of tables).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Christensen et al. to include an item custom data table to store an entry for the custom data for each item in the custom data group if the custom data form is displayed once for each item in the custom data group because storing data in tables is convenient and efficient process.

As per claim 19 Nishimura is directed to further comprising:

program code to obtain purchase information for the item (page 7, paragraph 0103, lines 5-6);

program code to obtain custom data using the custom data form (page 7, paragraph 0103, lines 7-9);

Nishimura does not teach program code to store the custom data and the purchase information.

Christensen et al. teaches program code to store the custom data and the purchase information (Christensen et al., page 5, paragraph 0049, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura by teachings of Christensen et al. to include saving the information in a database because it is more efficient to store the information about item and purchase data together for good recordkeeping.

As per claim 20 Nishimura as modified is directed to comprising program code to process the custom data (Nishimura, figure 4, s20, wherein processing happens when the purchase is submitted).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 2001/0051904 A1) and Christensen et al. (US 2002/0154114 A1) above, and further in view of Leber et al. (US 2003/0182391 A1).

As per claim 11 Nishimura and Christensen et al. do not teach concatenating custom data obtained for a plurality of input fields.

Leber et al. teaches concatenating custom data obtained for a plurality of input fields (Leber et al., figure. 2b, 288).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al. to include concatenating of data because doing so keeps all the relevant data together.

Nishimura and Christensen et al. as modified still do not teach storing the concatenated custom data as a large object in the database.

Leber et al. teaches storing the concatenated custom data as a large object in the database (Leber et al., page 4, paragraph 0067, lines 7-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Nishimura as modified by teachings of Leber et al.

to include saving the information in a database because it is more efficient to store the data in a repository that is easily accessed.

### ***Response to Arguments***

13. Applicant's arguments filed 9/13/2006 have been fully considered but they are not persuasive.

As to applicant arguments that Nishimura fails to teach comparing a set of attributes to a set of keys it is not deemed persuasive.

Nishimura teaches that after selecting specification type, which could be item type as explained in applicant's communication received on 9/13/2006, therefore it could be a key, and then retrieves a commodity having a combination of specifications, as recited in paragraph 0094. The retrieved commodity has to match the specification type to the combination of specifics to retrieve a commodity. The customizing choices deal with item-based attributes, as appearance of an item is item-based attribute. As the custom item is being build the components are selected from inventory, which could include attribute of availability. This could be a purchase-based attribute.

As to applicant's arguments that Nishimura does not display a custom data form is not deemed persuasive.

In paragraph 0028 Nishimura describes a page or a form which shows custom item made in response to user input.

In response to applicant's argument that Leber et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the art teaches concatenation, storage of concatenated strings and parsing of concatenated string. All those topics are well known in the art and Leber et al. could be used as reference.

In response that Leber et al. teaches away from the intended path of the invention is not deemed persuasive.

The inventions share a concept not the intended path of invention. In this case as both inventions describe manipulation of strings it is deemed that Leber et al. is relevant to be used as reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*



Art Unit: 2165

*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is found as cited by the office action.

In response to applicant's argument that Christensen et al. does not teach purchase-based attributes is not deemed persuasive.

Christensen et al. as stated in paragraph 0044 describes how the user could customize the product and therefore deals with item based attributes. The reference also retrieves information that deals with, for example inventory, which could include availability of the item. As stated by the applicant on page 10 of the response an attribute for an item could be quantity available, and as such qualifies Christensen et al. as useful reference.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2165


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski  
November 30, 2006

  
JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100